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**MAILED**

**MAY 14 2010**

**OFFICE OF PETITIONS**

In re Application of:	:	
Philips et al.	:	DECISION ON PETITION
Appl. No. 09/927,426	:	UNDER 37 CFR 1.183
Filed August 10, 2001	:	
Atty. Docket No. 95-L-024C3	:	
RE (1678-41)	:	

This is a decision on the August 19, 2009 renewed petition filed under 37 CFR 1.183<sup>1</sup> requesting suspension or waiver of the regulations that require the inventors to sign any supplemental declaration in a broadening reissue application.

Petitioner requests waiver of the rules (37 CFR 1.175(b)(1) is identified in the renewed petition) that requires that the inventors sign any supplemental declaration in a broadening reissue application.

The petition is Granted.

**BACKGROUND**

1. U.S. Patent No. 5,936,451 issued to William Phillips, Mario Paparo and Piero Capocelli on August 10, 1999.

2. A broadening reissue application (the present application) was filed on August 10, 2001, and it was assigned application number 09/927,426.

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<sup>1</sup>If a joint inventor refuses or cannot be found or reached to sign a supplemental oath/declaration, a supplemental oath/declaration listing all the inventors, and signed by all the available inventors may be filed provided it is accompanied by a petition under 37 CFR 1.183 along with the petition fee, requesting waiver of the signature requirement of the nonsigning inventor. MPEP 1414.01.

3. During the prosecution of the reissue application, the examiner's August 21, 2006 Office communication required a supplemental declaration directed to errors in the original patent which were corrected in the application after the signing of the original reissue declaration under 37 CFR 1.175(b)(1).

4. On November 2, 2006, applicant filed a petition under 37 CFR 1.47 properly treated under 37 CFR 1.183 requesting suspension or waiver of the "regulations pertaining to the filing of a Supplemental Declaration under 37 C.F.R. § 1.175" that require a supplemental reissue declaration to be signed by the inventors.

5. The petition filed February 27, 2009 was dismissed on June 19, 2009 because the supplemental declaration failed to include the citizenship of non-signing inventor Phillips pursuant to 37 CFR 1.175 and 1.63(a)(3).

6. The renewed petition is accompanied by a "Supplemental Reissue Declaration," signed by inventors Paparo and Capocelli. It is for this supplemental declaration that the petition requests acceptance, via suspension or waiver of the regulations.

7. The renewed petition proffers a showing, to establish that the non-signing inventor Phillips is unavailable to sign the supplemental reissue declaration. The discussion in the petition sets forth (a) the efforts made on behalf of the assignee to contact inventor Phillips and obtain the requisite signature on the supplemental declaration, and (b) the lack of success of such efforts.

#### DECISION

35 U.S.C. 251, which is directed to reissue, does not address the signature requirements of a declaration in reissue. 37 CFR 1.172 requires that a reissue declaration be made (and signed) by the inventors, except as otherwise provided (§§ 1.42, 1.43, 1.47), where the scope of the claims of the original patent is being enlarged.

37 CFR § 1.175(b)(1), requires that:

"For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant."

37 CFR 1.175(b)(1), taken in conjunction with 37 CFR 1.172, requires a supplemental declaration to be signed by all inventors. This is

because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and/or declaration must bear the appropriate signature of the inventor(s).

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37 CFR 1.183 permits, in an extraordinary situation, waiver of a rule which is not a requirement of the statute, where justice requires such waiver, and applicant has requested a waiver of the requirement that the 37 CFR 1.175(b)(1) supplemental declaration be signed by the inventors.

The instant petition provide an appropriate and sufficient showing that the inventor is unavailable to sign the supplemental declaration. In addition, absent a waiver of the rules, the assignee will be unable to obtain a reissue patent for the instant broadening reissue application, and will thus be irreparably damaged. Accordingly, the rules are hereby waived to the extent that the "Supplemental Reissue Application Declaration by the Assignee" submitted with the present petition will be accepted as though it was signed by the inventors as required by 37 CFR 1.175(b)(1) taken in conjunction with § 1.172. *See In re Hayes*, 53 USPQ2d 1222 (Comm'r Pat. 1999).

#### CONCLUSION

1. The petition under 37 CFR 1.183 is granted.
2. The provisions of 37 CFR 1.175(b)(1), and 37 CFR 1.172 are hereby waived to the extent that the November 11, 2006, "Supplemental Reissue Application Declaration by the Assignee" will be accepted as though it was signed by all of the inventors.
3. Please direct any questions related to this decision to Petitions Attorney Charlema R. Grant, at (571) 272-3215.

/Kenneth M. Schor/

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